

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	TOWLE et al.)	I hereby certify that this paper is
)	being submitted on this date:
U.S. Serial No.	:	10/664,475)	
)	Dated: October 19, 2006
Filed	:	September 17, 2003)	
)	
Title	:	METHODS AND)	
		APPARATUS TO)	<u>/Michael W. Zimmerman/</u>
		OPTICALLY COUPLE AN)	Michael W. Zimmerman
		OPTOELECTRONIC CHIP)	Registration No. 57,993
		TO A WAVEGUIDE)	
)	
Assignee	:	Intel Corporation)	
)	
Art Unit	:	2811)	
)	
Examiner	:	Ori Nadav)	

INTERVIEW SUMMARY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The undersigned would like to thank Examiner Nadav for the courtesies extended in a telephonic conference conducted on October 19, 2006. The applicants contacted Examiner Nadav in response to a voicemail from Examiner Nadav querying whether the applicants wished to abandon the application.

During the conference, the applicants indicated that they did not wish for the application to be abandoned. The applicants explained that an interview summary was filed with the examiner's supervisor Eddie Lee on December 7, 2005 indicating that the abandonment was improper. The applicants further explained that they had received a Decision on Petition dated December 20, 2005 indicating that the abandonment was rescinded and that the examiner was to issue an Office action.

Examiner Nadav indicated that he had not been notified by the Office of the Decision on Petition. Examiner Nadav requested that the applicants fax the Decision on Petition to him at 571-273-1660. The applicants have faxed the Decision on Petition to the examiner. A copy of the Decision on Petition is also attached hereto. Examiner Nadav indicated that the application would be in order after he received the Decision on Petition. Accordingly, the applicants look forward to receiving a response on the merits of this application.

The undersigned hereby thanks Examiner Nadav for his courtesy and professionalism in handling this matter in a manner to ensure that the applicants are not prejudiced by the above-noted PTO actions.

Respectfully submitted,

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By: /Michael W. Zimmerman/
Michael W. Zimmerman
Registration No. 57,993
Agent for Intel Corporation

October 19, 2006

Enclosure: Copy of the Decision on Petition dated December 20, 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:
Steven Towle et al.
Serial No.: 10/664,475
Filed: September 17, 2003
For: METHODS AND APPARATUS TO OPTICALLY
COUPLE AN OPTOELECTRONIC CHIP TO A
WAVEGUIDE

DECISION ON PETITION

This is a response to applicant's telephonic inquiry and a written communication entitled "Interview Summary" filed December 7, 2005, via facsimile transmission, which is treated as a petition to withdraw the holding of abandonment of the above-identified application.

The petition is GRANTED.

This application was held abandoned for failure to respond in a timely manner to the restriction requirement of October 5, 2004. A Notice of Abandonment was mailed on December 1, 2005.

Petitioner states that the holding of abandonment is improper because the restriction requirement of October 5, 2004, is a second restriction requirement that is based on the same ground as that set forth a first restriction requirement of June 25, 2004. Petitioner asserts that prior to receipt of the second restriction requirement, petitioner was contacted by the then examiner of record to inform petitioner that the restriction requirement was issued in error and should have been disregarded. Petitioner was also informed that the erroneous action would be replaced by an Office action on the merits. On December 6, 2005, petitioner received a notice of abandonment indicating that the application was held abandoned for failure to reply to the second restriction requirement.

A review of the application record reveals that in response to the first restriction requirement requiring election between two groups of claims that were deemed to be directed to two patentably distinct inventions: Group I with claims 1-25 and Group II with claims 26-44. The reply to the restriction requirement filed July 26, 2004 canceled claims 26-44 and thus restricted examination to claims 1-25, all the claims pending at this time. The second restriction

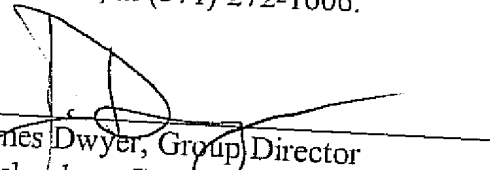
requirement of October 5, 2004, required petitioner to again restrict the claims to one of two groups of claims: Group I with claims 1-25 and Group II with claims 26-44 (canceled).

It is clear from the record that the second restriction requirement made by the examiner is defective since there were and are only claims 1-25 pending in the application for examination. It is also clear from the record that an action on the merits of claims 1-25 was a proper Office action to be issued and the second restriction requirement must be vacated. However, due to some procedural error on the part of the USPTO, the application was reassigned to a different examiner and the second restriction requirement was not officially vacated in writing and resulted in the mailing of the notice of abandonment. Although the fact that a conversation between the examiner and the attorney before the receipt of the second restriction requirement was not reflected in writing, it is apparent that an agreement was reached that the second restriction requirement was improper and withdrawn and that an Office action on the merits would be issued promptly without any reply needed from the petitioner. The fact that an Office action vacating the second restriction requirement and treating claims 1-25 on the merits was clearly a USPTO error that was compounded by the mailing of the notice of abandonment.

In view of the above-stated reasons and based on the special circumstances surrounding this application, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The examiner will issue a new Office action based on claims 1 through 25 currently pending.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.



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